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In re Application of BIRD et al.
Application No.: 10/523,153
PCT No.: PCT/AU03/00954
Int. Filing: 29 July 2003
Priority Date: 29 July 2002
Attorney Docket No.: 83950
For: A BULK COMMUNICATIONS PROCESS
USING MULTIPLE DELIVERY MEDIA

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This is a renewed decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 01 May 2007, to accept the application without the signatures of joint inventors, Kevin Bryan Levine and Michael Robert Stewart. Applicant's request for a five month extension of time is granted.

BACKGROUND

On 02 October 2006, a decision dismissing the 26 July 2006 petition was mailed to applicant, indicating that Petitioner had not demonstrated that a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/523,153 (specification, including claims, drawings, and declaration) to the nonsigning inventors for their signature and both Mr. Stewart's and Mr. Levine's refusal to sign, either in writing or by telephone, these documents.

On 01 May 2007, applicant filed a renewed petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(g), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Items (1), (3) and (4) were previously satisfied.

With respect to Item (2) above, the statements of facts by Carl David Harrap and Iain

Bartram were presented concerning the 37 CFR 1.47(a) applicant's attempt to obtain the signatures of nonsigning inventors Kevin Bryan Levine and Michael Robert Stewart.

Mr. Harrap relates his attempt to present the application papers to Mr. Levine. Correspondence including a complete set of application papers was sent to and signed for by Mr. Levine on 28 July 2006. Mr. Harrap also indicates that he placed numerous phone calls to Mr. Levine, leaving a message for a return call. These messages went without reply by Mr. Levine. This is sufficient evidence to conclude that Mr. Levine refuses to sign the application papers.

With regard to inventor Stewart's signature, Mr. Bartram's declaration indicates that a colleague of Mr. Stewart, Alex Omilian has contacted Mr. Stewart and relates that Mr. Stewart does not want to have any communication from ConnXion. This does not relieve Petitioner from attempting to contact Mr. Stewart, giving him an opportunity to sign the application papers.

As indicated in the MPEP Section 409.03(d), where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

The 37 CFR 1.47(a) applicant has not yet demonstrated that Mr. Stewart was presented with a copy of all of the national stage application papers (specification, including claims and drawings, oath or declaration) for this application and refuses to sign. Mr. Bartram indicates that Mr. Stewart no longer resides in Sydney, Australia but has moved to London. Mr. Bartram does not detail any attempts to search the Internet for a current address for Mr. Stewart. Mr. Bartram indicates he purchased an electoral role and noted that 20 names were listed. He presented the list to Mr. Omilian; Mr. Omilian indicated that none of the addresses belonged to Mr. Stewart. By Mr. Bartram's own admission, the use of an electoral role would produce a result only if Mr. Stewart was registered to vote, which may not be the case. Moreover, a first hand statement from Mr. Omilian was not provided, to show that Mr. Omilian himself made an attempt to present the application papers to Mr. Stewart, which Mr. Stewart refused.

Here, diligent efforts to locate the nonsigning inventor using an Internet search were not pursued and documented to obtain Mr. Stewart's current address, current email address and/or current employer. In the petition filed on 26 July 2006, Mr. Harrap indicated that he attempted to find Mr. Stewart's current address at www.whitepages.com.au for a listing on Foss Street. No such attempt to find the nonsigning inventor in Great Britain was conducted after learning that Mr. Stewart was in London. Nor was an attempt made to reach the nonsigning inventor by telephone. A request from the Postal Service for Mr. Stewart's forwarding address was not made. Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a "diligent effort" was made. Petitioner's statement of facts under 37 CFR 1.47(a) does not indicate that any internet search for Mr. Stewart's new address was made. Since no further attempts to locate the nonsigning inventor were documented, it can not be concluded that "a diligent effort" was made to locate the non-signing inventor.

The action taken by petitioner is not sufficient to prove that "a diligent effort" was made to contact the nonsigning inventor Michael Robert Stewart. Under these circumstances, it cannot be concluded that then nonsigning inventors are unavailable to sign the application. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

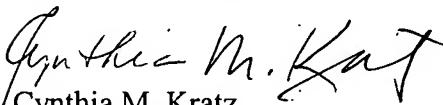
In sum, Petitioner has satisfied Items (1), (3) and (4) above. However, Petitioner has not satisfied Item (2) by demonstrating: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/523,153 (specification, including claims, drawings, and declaration) to the nonsigning inventor Stewart for his signature and that Mr. Stewart refused to sign, either in writing or by telephone, these documents. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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